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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,639	06/25/2001	Mitsuo Nakayama	HAG137	1854

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EXAMINER

MARIAM, DANIEL G

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,639

Applicant(s)

NAKAYAMA, MITSUO

Examiner

DANIEL G MARIAM

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Translation

1. An unofficial computer English translation, which has the same format (i.e., paragraph numbers) as Japanese Patent Numbers (07-028801 and 09-282084) is provided to the applicant.

This translation is also available on-line at (URL): http://www.ipdl.jpo.go.jp/homepg_e.ipdl,

and use the following instruction to get the unofficial computer English translation of the '610 JP patent:

Click on searching PAJ
Click on Number Search
Enter the number and click search
In the results window click on the number.
Click on details at the top.
A separate framed window comes up.
In the top frame, click the section that you want translated. It is slow so be patient. To print, just click somewhere in the frame with the translation, and click on print.

The Examiner has used the unofficial translation for the interpretation of Japanese Patent

Numbers 07-028801 and 09-282084. An official translation will be provided with the next

Office Action, up on applicant's request.

Abstract

2. This application does not contain an abstract of the disclosure as required by 37

CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 7, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. Claim 1, part “e” recites the limitation “an operating part which fixes said code information”. It is unclear why the code information requires fixing by the operating part. A similar limitation also occurs in both claims 7 and 10. Please clarify.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 6-7, and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Rokuto, et al (Computer Translation of Japanese Patent No. 07-028801).

With regard to claim 1, an image scanner that gives and receives information between said scanner and a personal computer loaded with character recognition software and at least one application software (See for example, Figure 1), comprising

(a) an image sensor taking character information on any intended region, i.e., an image region that contains alphabetic character, of document as image information by optically scanning, and (b) an output part which outputs said taken image information to a personal computer, and (c) an input part which inputs recognition results from said personal computer after recognizing said image information with said character recognition software, and (d) a display part which shows said code information, and (e) an operating part which fixes said code information, and which is characterized by the fact that said code information is outputted to said personal computer through said output part so as to insert said fixed code information into the

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designated cursor position on said application software working presently, responding to said operating part (See paragraph 12 through paragraph 29; and Figs 1-23).

With regard to claim 2, the image scanner of the claim 1, which is characterized by the fact that said scanner has pointing device function of said personal computer (See for example, paragraph 27).

With regard to claim 6, the image scanner of claim 1, which is characterized by the fact that said code information is shown in said display part at real time and said code information is able to be changed until said fixing operation is done (paragraphs 12, and 25-29).

With regard to claim 7, claim 1 encompasses the limitation of this claim, and is rejected the same as claim. Thus, argument analogous to that presented above for claim 1 is equally applicable to claim 7.

Claim 10 is rejected the same as claim 1 except claim 10 is a method claim. Thus, argument similar to that presented above for claim 1 is equally applicable to claim 10.

With regard to claim 11, the data input method stated in the claim 10, which is characterized by the fact that at least one application software is a program software which enables to use said code information as byte Asian, i.e., Japanese, language in operating system, and said code information is inputted through said program (hooking) software into said at least one application software working presently (See Figs. 3-30).

With regard to claim 12, the data input method stated in the claim 10, which is characterized by the fact that both said code information and said image information are shown in the displaying picture of said personal computer, and said code information is amended with referring to said image information shown (See Figs. 6-24).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rokuto, et al (Computer Translation of Japanese Patent No. 07-028801) in view of Ie, et al. (Computer Translation of Japanese Patent No. 09-282084).

With regard to claim 3, Rokuto, et al (hereinafter "Rokuto") discloses all of the claimed subject matter as already discussed above in paragraph 6, and the arguments are not repeated herein, but are incorporated by reference. While Rokuto mentions a mouse used a pointing device which specifies the point of arbitration on the display screen, Rokuto does not elaborate the mouse being a scanner mouse having mouse function as said pointing device. However, Ie, et al. (Figs. 1 and 2) teaches this feature.

Rokuto and Ie, et al are combinable because they are from the same field of endeavor, i.e., character recognition and/or alphabetic character recognition (See for example, Fig. 2). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Ie, et al. with Rokuto. The motivation for doing so would at least enhance the system of Rokuto because it would at least make the scanning operation easier and more flexible, and thereby improving the recognition rate of the alphabetic characters. It would have been obvious to combine Ie, et al. with Rokuto to obtain the invention as specified in claim 3.

With regard to claim 4, the image scanner of claim 3, which is characterized by the fact that this image scanner has a sensor circuit that utilizes the position signal of said mouse or the position signal of an image sensor as a position signal of the scanner (See for example, paragraph 16 and paragraph 43; and Figs. 1 & 2 of *Ie, et al*).

With regard to claim 5, the image scanner of claim 2, which is characterized by the fact that this image scanner is connected to said personal computer by high-speed bi-directional communication bus (which reads on Fig. 9 of *Ie, et al*).

9. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Rokuto, et al* (Computer Translation of Japanese Patent No. 07-028801) in view of *Harris* (5,438,436).

With regard to claim 8, *Rokuto, et al* (hereinafter “*Rokuto*”) discloses all of the claimed subject matter as already discussed above in paragraph 6, and the arguments are not repeated herein, but are incorporated by reference. *Rokuto* does not explicitly call for the application software as being a voice synthesis software and said code information is outputted by converting into corresponding voice information. However, *Harris* (Figs. 34 and 36) teaches this feature. Therefore, it would have been obvious to one having ordinary skill in the art to incorporate the teaching as taught by *Harris* into the system of *Rokuto*, if for no other reason than to have a voice synthesizing software, and to do so would at least allow the manipulation (or recognition) of voice information.

With regard to claim 9, the optical character recognition system stated in claim 7, which is characterized by the fact that said at least one application software includes voice recognition software and said code information is amended responding to the voice instruction, i.e., command, for amending (See for example, Fig. 36 of *Harris*).

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Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent Numbers: 4614978, 5271067, 5509092, 5627661, and 6456739.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL G MARIAM whose telephone number is 703-305-4010. The examiner can normally be reached on M-F (7:00-4:30) FIRST FRIDAY OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LEO BOUDREAU can be reached on 703-305-4607. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DANIEL MARIAM
PRIMARY EXAMINER
June 25, 2004